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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3
4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

7
8 *Ex parte* BRIAN R. McCLAIN, DAVID T. NAY
9 and WILLAM VIGILANTE, JR.
10

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12 Appeal 2008-1775
13 Application 10/776,943
14 Technology Center 3600
15

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17 Decided: August 28, 2008
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19

20 *Before* JENNIFER D. BAHR, JOSEPH A. FISCHETTI and DANIEL S.
21 SONG, *Administrative Patent Judges*.

22
23 SONG, *Administrative Patent Judge*.
24

25 DECISION ON APPEAL
26

27 STATEMENT OF CASE

28 The Appellants appeal under 35 U.S.C. § 134 (2002) from a Final
29 Rejection of claims 1, 5, 10, 11 and 21-23. Claims 4, 6, 8 and 13-20 stand
30 withdrawn from consideration. Claims 2, 3, 7, 9 and 12 have been
31 previously canceled. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

1 The Appellants claim an apparatus for storing computing devices on a
2 computer equipment rack such that an upper support and a lower support of
3 the apparatus can be transitioned to a vertical storage position
4 (Specification 5: ¶ [013]).

5 The sole independent claim reads as follows:

- 6 1. An apparatus for compactly storing computing devices,
7 comprising:
8 an upper support comprising a rigid material forming a
9 planar vertical back with substantially perpendicular edge
10 protrusions along planar vertical back edges and configured to
11 receive a display device;
12 a lower support comprising a rigid material forming a
13 tray configured to receive a keyboard and an integrated pointing
14 device; and
15 a mounting mechanism that connects the upper support to
16 the lower support and allows the upper support and the lower
17 support to transition between an access position and a vertical
18 storage position, the mounting mechanism mounted to a
19 computer equipment rack such that the vertical storage position
20 is outside of the computer equipment rack and places the upper
21 support and lower support behind a face of the computer
22 equipment rack, wherein the computer equipment rack is
23 configured to mount equipment with a height that is an integer
24 multiple of 44.45 millimeters and the face is configured as a
25 virtual vertical plane of the computer equipment rack wherein a
26 user may access equipment mounted within the computer
27 equipment rack.

28
29 The prior art relied upon by the Examiner in rejecting the claims is:

| | | |
|----------------|-----------------|---------------|
| 30 Harbin | US 6,286,794 B1 | Sep. 11, 2001 |
| 31 Oddsen, Jr. | US 6,783,105 B2 | Aug. 31, 2004 |

1 Felcman US 6,945,412 B2 Sep. 20, 2005

2 The Examiner rejected claims 1, 5, 10, 11 and 22 under 35 U.S.C.
3 § 102(b) as lacking novelty over Harbin.

4 The Examiner rejected claim 21 under 35 U.S.C. § 103(a) as
5 unpatentable over Harbin.

6 The Examiner also rejected claims 1, 5, 22 and 23 under 35 U.S.C.
7 § 103(a) as unpatentable over Felcman and Oddsen.

8 We AFFIRM-IN-PART.

9

10 ISSUES

11 The following issues have been raised in the present appeal.

12 1. Whether the Appellants have shown that the Examiner erred in
13 rejecting claims 1, 5, 10, 11 and 22 as lacking novelty over Harbin.

14 2. Whether the Appellants have shown that the Examiner erred in
15 rejecting claim 21 as unpatentable over Harbin.

16 3. Whether the Appellants have shown that the Examiner erred in
17 rejecting claims 1, 5, 22 and 23 as unpatentable over Felcman and Oddsen.

18

19 FINDINGS OF FACT

20 1. Harbin describes an apparatus for compactly storing computing
21 devices 14, 58 including an upper support 16 for receiving a display device
22 74, a lower support 26 for receiving a keyboard 126, and a mounting
23 mechanism 18, 24, 28 that connects the upper support to the lower support
24 and allows the upper support and the lower support to transition between a

1 lowered position (i.e., an access position) and an elevated storage position
2 (i.e., a vertical storage position) (Figs. 1 and 4; Col. 4, l. 59-Col. 5, l. 10;
3 Col. 7, ll. 37-48).

4 2. Harbin describes mounting the mounting mechanism to a
5 computer equipment rack (hollow column 38) which is configured to mount
6 computer equipment 14, 58 (Fig. 1; Col. 4, ll. 62-Col. 5, ll. 10). Harbin also
7 describes the upper support and lower support which are positioned outside
8 of the computer equipment rack (Fig. 1).

9 3. Harbin further describes the mounting mechanism as mounted
10 to a swivel bracket 32 which allows a rotational range of motion of the upper
11 support and the lower support (Col. 6, ll. 48-55). In addition, further
12 rotational range of motion is provided to the upper and lower supports by the
13 provided swivels (Col. 6, ll. 55-65). Thus, Harbin describes a device in
14 which the upper support and lower support can be positioned at least
15 partially behind a face of the computer equipment rack, i.e., the column 38.
16

17 PRINCIPLES OF LAW

18 “A claim is anticipated only if each and every element as set forth in
19 the claim is found, either expressly or inherently described, in a single prior
20 art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d
21 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over
22 the prior art under 35 U.S.C. § 102 begins with a determination of the scope
23 of the claim. We determine the scope of the claims in patent applications
24 not solely on the basis of the claim language, but upon giving claims their

1 broadest reasonable construction in light of the specification as it would be
2 interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech.*
3 *Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim
4 must then be compared with the prior art. In addition, “[i]t is well settled
5 that a prior art reference may anticipate when the claim limitations not
6 expressly found in that reference are nonetheless inherent in it.” *In re*
7 *Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349 (Fed. Cir. 2002)

8 “Section 103 forbids issuance of a patent when ‘the differences
9 between the subject matter sought to be patented and the prior art are such
10 that the subject matter as a whole would have been obvious at the time the
11 invention was made to a person having ordinary skill in the art to which said
12 subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727,
13 1734 (2007). The question of obviousness is resolved on the basis of
14 underlying factual determinations including (1) the scope and content of the
15 prior art, (2) any differences between the claimed subject matter and the
16 prior art, (3) the level of skill in the art, and (4) where in evidence, so-called
17 secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18
18 (1966). In *KSR*, the Supreme Court explained that “[o]ften, it will be
19 necessary for a court to look to interrelated teachings of multiple patents; the
20 effects of demands known to the design community or present in the
21 marketplace; and the background knowledge possessed by a person having
22 ordinary skill in the art, all in order to determine whether there was an
23 apparent reason to combine the known elements in the fashion claimed by
24 the patent at issue.” *KSR*, 127 S.Ct. at 1740-41. The Court noted that “[t]o

1 facilitate review, this analysis should be made explicit.” *Id.* at 1741, citing
2 *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on
3 obviousness grounds cannot be sustained by mere conclusory statements;
4 instead, there must be some articulated reasoning with some rational
5 underpinning to support the legal conclusion of obviousness”). However,
6 “the analysis need not seek out precise teachings directed to the specific
7 subject matter of the challenged claim, for a court can take account of the
8 inferences and creative steps that a person of ordinary skill in the art would
9 employ.” *Id.* at 1741.

11 ANALYSIS

12 Rejection of claims 1, 5, 10, 11 and 22 as lacking novelty over Harbin

13 The Examiner rejected these claims finding that Harbin describes each
14 and every limitation¹ (Ans. 3). Initially, the Appellants contend that Harbin
15 does not disclose “a mounting mechanism that allows an upper support and a
16 lower support to transition between an access position and a vertical storage
17 position” recited in independent claim 1 (Br. 7 and 9). In particular, the

¹ The Appeal Brief on page 16 asserts another issue to be reviewed on appeal is whether the Examiner properly considered the Appellants’ argument made after final rejection regarding the anticipation rejection of claim 1 based on the Examiner’s comment in the Advisory Action of October 27, 2006 (App. Br. 6 and 16). However, this issue is not within the jurisdiction of the Board and appears to be moot given the Examiner’s clarifying remarks in the Examiner’s Answer (Answer 13, 14) which the Appellants’ Reply Brief (Reply Br. 12) acknowledges.

1 Appellants contend that Harbin merely describes changing the vertical
2 height of the computer workstation that is in an access position, and does not
3 describe the lower support and upper support assuming a vertical storage
4 position (Reply Br. 3).

5 The Examiner responds that this limitation is met by the device of
6 Harbin “being vertically cleared out of a work area while a user is
7 performing other tasks” (Ans. 8). We agree. During prosecution, claims are
8 to be given their broadest reasonable construction in light of the
9 Specification as it would be interpreted by one of ordinary skill in the art. *In*
10 *re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). In
11 addition, “[a]bsent claim language carrying a narrow meaning, the PTO
12 should only limit the claim based on the specification or prosecution history
13 when those sources expressly disclaim the broader definition.” *In re Bigio*,
14 381 F.3d 1320, 1325 (Fed Cir. 2004).

15 However, the term “vertical” is defined by *Merriam-Webster’s*
16 *Collegiate Dictionary* (11th Ed., 2007) as “situated at the highest point,”
17 which occurs in Harbin when the upper support and the lower support are in
18 an elevated storage position (i.e., a vertical storage position) (FF 1). In
19 addition, there does not appear to be a specific definition of the term
20 “vertical”, or a disclaimer within the Specification of the broader definition
21 of “vertical” which encompasses the vertical storage position described in
22 Harbin. Thus, in view of the above, we agree with the Examiner that when
23 broad construction of the term “vertical” is applied, the vertical storage
24 position recited in these claims is described in Harbin.

1 The Appellants also contend that Harbin does not describe a computer
2 equipment rack, stating that those in the art would not interpret the open
3 track of Harbin as the recited “computer equipment rack” and that the
4 definition of the term “rack” applied by the Examiner is overly broad (App.
5 Br. 9; Reply Br. 3-5). However, we agree with the Examiner’s position that
6 the column 38 and the CPU tray 12 of Harbin serve as a framework or stand
7 (i.e., a rack) for holding computer equipment (i.e., the CPU and/or data
8 cables) (Ans. 8 and 9). We do not find the Appellants’ argument asserting
9 that “computer equipment rack” has an industry standard meaning which
10 precludes Examiner’s broad interpretation to be persuasive evidence (Reply
11 Br. 5).

12 The Appellants also argue that Harbin does not describe a vertical
13 storage position outside of a computer equipment rack which places the
14 upper support and lower support behind a face of the computer equipment
15 rack (App. Br. 9; Reply Br. 4). However, we note that the parallelogram
16 arm assembly, as well as the upper and lower support of Harbin are
17 pivotable, and thus, can be positioned so as to satisfy the recited limitation
18 (FF 3).

19 The Appellants further contend that Harbin does not describe a
20 computer equipment rack which is configured to mount equipment with a
21 height that is an integer multiple of at least one of 44.45 millimeters (App.
22 Br. 9; Reply Br. 6). However, the Examiner is correct in noting that the
23 “equipment” having the recited height is not a required component of the
24 claimed apparatus and that Harbin satisfies this limitation because the

1 column 38 and/or the CPU tray 12 of Harbin can support such equipment
2 with the recited height dimension (Ans. 9). In this regard, we note that the
3 Appellants' assertion that the Examiner is improperly ignoring limitations
4 that further define and clarify the term "computer equipment rack" is
5 misdirected because claim 1 merely recites that the rack is "configured to
6 mount "equipment" that has the recited height dimension (Reply Br. 6; Ans.
7 9). In other words, the claim merely requires that the rack be capable of
8 having such equipment mounted thereon. Hence, this limitation is satisfied
9 by the column/CPU tray of Harbin which is capable of mounting such
10 equipment.

11 In view of the above, the Appellants have failed to show that the
12 Examiner erred in rejecting claim 1 as lacking novelty over Harbin. The
13 Appellants do not argue the dependent claims 5, 10, 11 and 22 separately,
14 but instead, merely rely on their ultimate dependency from claim 1 for
15 patentability (App. Br. 9). Thus, these claims fall with independent claim 1
16 and the Appellants have not shown that the Examiner erred in rejecting these
17 dependent claims as well. *See* 37 C.F.R. § 41.37(c)(1)(vii).

18
19 Rejection of claim 21 as unpatentable over Harbin

20 The Examiner rejected claim 21 as unpatentable, finding that Harbin
21 specifically teaches motorizing the travel of the carriage 24 and/or the dual
22 parallelogram arm assembly 28 (Ans. 4 and 5). The Appellants contend that
23 Harbin does not teach motorizing the transition between an access position
24 and a vertical storage position (App. Br. 10 and Reply Br. 7). The

1 Appellants' position is again based on the argument that Harbin does not
2 describe a vertical storage position (App. Br. 11 and Reply Br. 7). However,
3 this line of reasoning is not persuasive as discussed *supra* in view of the
4 definition of the term "vertical" (FF 2). As the Examiner noted, Harbin
5 suggests motorizing the travel of the carriage 24/arm assembly 28 so that
6 transitioning of the upper and lower supports between an access position and
7 a vertical storage position (i.e., elevating the supports to be "situated at the
8 highest point") is motorized. Thus, we agree with the Examiner that claim
9 21 is unpatentable over Harbin and find that the Appellants have failed to
10 show that the Examiner erred.

11
12 Rejection of claims 1, 5, 22 and 23 as unpatentable over Felcman and
13 Oddsens

14 The Examiner also alternatively rejected claims 1, 5, 22 and 23 as
15 unpatentable over Felcman and Oddsens, finding that various deficiencies of
16 Felcman's mounting system are cured by the adjustable display arm of
17 Oddsens (Ans. 5-7).

18 The Appellants argue that there is no suggestion to combine Felcman
19 and Oddsens in the manner suggested by the Examiner (App. Br. 15). While
20 explicit teachings or suggestions in the references are not required, we agree
21 with the Appellants that the Examiner's articulated reasoning is insufficient
22 for us to conclude that the claimed invention would have been obvious to
23 one of ordinary skill in the art.

1 Specifically, the Examiner finds that it would have been obvious to
2 one of ordinary skill in the art to attach the mounting arm of Oddsen to the
3 rack of Felcman (Ans. 7). The Examiner reasons that mounting the device
4 of Felcman requires the use of internal space that could otherwise be used
5 for additional hardware, and observes that Oddsen suggests storing
6 components at an elevated level to save desktop space (Ans. 12). Thus, the
7 Examiner concludes that it would be obvious to attach the adjustable arm
8 assembly disclosed by Oddsen to either the frame member or a divider panel
9 of the rack of Felcman in order to free up internal space within the rack of
10 Felcman (Ans. 12).

11 However, we are not persuaded that a person with ordinary skill in the
12 art would know to mount the adjustable arm assembly of Oddsen to the
13 frame member or to the divider panel of the rack of Felcman.

14 The Examiner finds that the display arm of Oddsen being described as
15 attached to a wall does not preclude the display arm from being attached to
16 another surface such as the rack of Felcman (Ans. 13). While we agree with
17 the Examiner's statement, it is not apparent how the combination results in
18 the claimed invention. Combination of the teachings of Felcman and
19 Oddsen would appear to result in either the display arm being mounted
20 within the rack of Felcman, in a manner which would not be capable of
21 providing a vertical storage position outside the rack, as required by the
22 claims, or the display arm being mounted high on an adjacent wall surface
23 via structure distinct from Felcman's rack (Oddsen; Col. 5, ll. 9-17), which
24 again would not meet the requirements of the claims. While the Examiner

1 has articulated a rational reason for combining these references (Final 5, 6),
2 the resulting combination would not meet the requirements of the claims.

3 In view of the above, we find that the Appellants have shown that the
4 Examiner erred in rejecting independent claim 1 as unpatentable over
5 Felcman and Oddsen. We therefore cannot sustain the rejection of claim 1,
6 or claims 5, 22 and 23 that depend from claim 1.

7
8 CONCLUSIONS

9 1. The Appellants have not shown that the Examiner erred in
10 rejecting claims 1, 5, 10, 11 and 22 as lacking novelty over Harbin.

11 2. The Appellants have not shown that the Examiner erred in
12 rejecting claim 21 as unpatentable over Harbin.

13 3. The Appellants have shown that the Examiner erred in rejecting
14 claims 1, 5, 22 and 23 as unpatentable over Felcman and Oddsen.

15
16 ORDERS

17 1. The decision to reject claims 1, 5, 10, 11, 21 and 22 is
18 AFFIRMED.

19 2. The decision to reject claim 23 is REVERSED.

20 No time period for taking any subsequent action in connection with
21 this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. §
22 1.136(a)(1)(iv) (2007).

23
24 AFFIRMED-IN-PART

Appeal 2008-1775
Application 10/776,943

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